

-10-

REMARKS

In Amendment A filed September 22, 2005, applicant provided the Examiner notice of the fact that the present application was previously granted special status. An application for patent that once has been made special and advanced out of turn by the Office for examination will continue to be special throughout its entire course of prosecution in the Patent and Trademark Office, including appeal, if any, to the Board. (See MPEP 1204 & 708.02).

Further, applicant noted that, as stated in MPEP 708.02, during the 3-month period for reply, applicant is encouraged to arrange for an interview with the examiner in order to resolve, with finality, as many issues as possible. Still yet, applicant requested an interview with the Examiner, if a notice of allowance was not issued in response to Amendment A. It is noted that, before final, the Examiner did not satisfy such request, despite applicant's multiple attempts to contact the Examiner by phone shortly after filing Amendment A.

The Examiner has provisionally rejected the claims on the ground of non-statutory double patenting. It appears that the Examiner has overlooked the terminal disclaimer already filed May 03, 2004, copy attached.

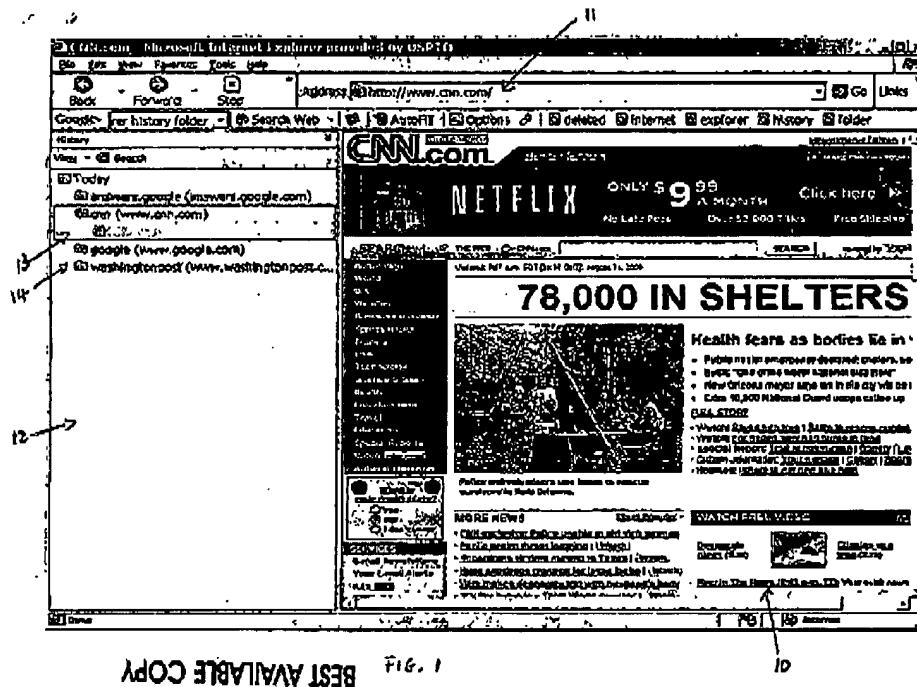
The Examiner has rejected Claims 2, 19, and 26 under 35 U.S.C 112, second paragraph. Such rejection is deemed avoided by virtue of the clarifications made hereinabove to the claims.

The Examiner has again rejected Claims 1-24 under 35 U.S.C 102(a) as being anticipated by MS Internet Explorer (IE). Applicant respectfully disagrees with such rejection, especially in view of the amendments made hereinabove.

In response to applicant's previous arguments regarding the claimed "wherein a user is allowed to pre-select one of the identifiers" (see this or similar, but not necessarily identical, language in each of the independent claims), the Examiner argued that such language is met by Fig. 2 and 3 in IE, since "a user can

pre-select identifiers 21 from fig. 2 by clicking on the identifiers, content is displayed in the browser; in addition a user can also select the identifier by entering input in area 11 and of fig. 1)’’ (emphasis added).

Thus, regarding Claim 1, the Examiner relies on area 11 from Fig. 1 below to meet applicant's claimed technique "wherein the user is allowed to manually enter the pre-selected identifier."



It appears, however, that, in order to meet applicant's claims, the Examiner is now attempting to rely on URL 11 in IE to meet both applicant's claimed "URLs" and "pre-selected identifier." Applicant respectfully disagrees with this approach, as applicant clearly claims two separate entities (e.g. "URLs" and a "pre-selected identifier").

Nevertheless, despite such paramount distinction and in the spirit of expediting the prosecution of the present application, applicant now claims that the

“pre-selected identifier” or “identifiers,” are “non-inclusive of any portion of” (Claim 1 et al), “separate from” (Claim 20), “distinct with respect to” (Claim 21), or “different from” (Claim 22 et al.) the claimed “URLs.”

Moving on, still in regards to Claim 1, the Examiner still relies on Fig. 1 below from IE to make a prior art showing of applicant's claimed "plurality of identifiers adjacent to the window in which the content is displayed," "wherein a user is allowed to pre-select one of the identifiers" (see this or similar, but not necessarily identical, language in each of the independent claims, as amended).

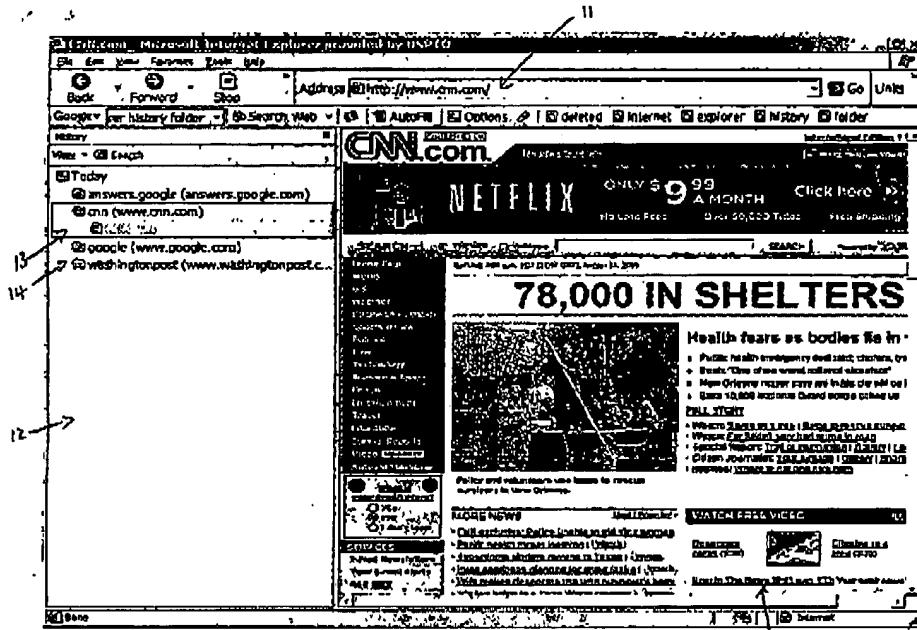


FIG. 11

Specifically, the Examiner relies on identifiers 13 and 14 to meet applicant's claimed pre-selected identifiers. However, such identifiers 13 and 14 are not "non-inclusive of any portion of" the URL, as claimed by applicant. Instead, quite to the contrary, the identifiers 13 and 14 include the URL.

-13-

Still yet, the Examiner relies on “(Figs 2-5; selection of element 20 and 22 of fig. 2, and selection of element of 40 and 41 of Fig. 4 are stored); see list 50 of fig. 5)” to meet applicant’s claimed technique “wherein, after the pre-selection, selected content associated with at least one of the URLs displayed during use of the network browser is correlated with the pre-selected identifier and stored.”

However, such figures show some sort of correlation and storage of content with an identifier associated with the corresponding URL, and not a “pre-selected identifier” “non-inclusive of any portion of” the URL, as claimed by applicant. Again, content is correlated with a URL-related identifier in IE.

Applicant asserts that this paramount deficiency is rooted in the fact that the foregoing feature from IE is simply a “history” feature that merely tracks which web pages have been visited in association with various sites, and not a feature that allows the user to manually pre-select ANY identifier of choice such that selected content associated with URLs displayed during use of the network browser may be correlated with such pre-selected identifier and stored.

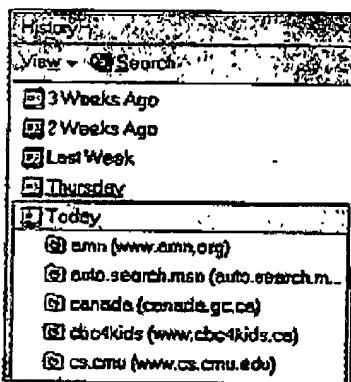
Further, it would be *unobvious* to equip IE with applicant’s claimed feature. Note, for example, the description of the “history” feature below that was provided by the Examiner.

Using History

You can revisit sites by using History. IE5 keeps a record of the sites you have visited for up to three weeks. To backtrack to earlier sessions select View from the menubar, then Explorer Bar and then History. Or just click on the History button in the toolbar.



The History Folder will appear down the left side of the screen and the page you were viewing will be shifted to the right. A list of the sites that you have visited are displayed in this frame. Most sites will have a yellow folder preceding the URL. Click on the yellow folder to see a list of the pages you have visited at that site.



The record keeping of visited sites carried out by the "history" feature requires that identifiers simply be automatically post-selected after a page is browsed in a manner that is transparent to the user (e.g. by simply post-selecting the identifier to match the title and/or URL of the web page, etc.). To allow a user to manually pre-select identifiers (in the context claimed) during such tracking would defeat the purpose of the "history" feature, as it would entail too much user intervention in order to provide the convenient "backtracking" mentioned above. To this end, the "history" feature of IE *teaches away* from applicant's claimed invention.

It is further noted that the Examiner has not considered the full weight of all of applicant's claim language. Specifically, the Examiner has merely rejected Claims 20-24 "under the same rationale as claim 1." However, indicated below is exemplary language (in a form that preceded the above amendment) that was not fully considered in making such rejection.

-15-

"wherein the pre-selected identifier is capable of being manually modified by the user utilizing a user-selectable object adapted for modifying" (emphasis added - see Claim 21)

"wherein the pre-selected identifier is capable of being manually entered by the user manually adding to the plurality of identifiers utilizing an icon adapted for adding to the plurality of identifiers" (see Claim 23)

The Examiner is reminded that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. Of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Moreover, the identical invention must be shown in as complete detail as contained in the claim. *Richardson v. Suzuki Motor Co.* 868 F.2d 1226, 1236, 9USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim.

This criterion has simply not been met by the IE reference. A notice of allowance or specific prior art showing of each of the foregoing claim elements, in combination with the remaining claimed features, is respectfully requested.

It is again noted that the aforementioned distinctions (in the context claimed) offer numerous advantages (which further render such features *unobvious*). The tremendous benefit of such clear distinction may be illustrated with an optional, non-limiting example of use, set forth below.

In the present example, imagine a user performing Internet research relating to two separate fruits, namely apples and oranges. In such case, the user may be allowed to manually enter an apple identifier and an orange identifier. The user may wish to first research apples. In the context of the claimed invention, the user would first "pre-select" the identifier reflecting "apples." "[T]hereafter" or "after the pre-selection," while browsing, the user may simply select content relating to "apples" for storage and correlation in association with the "pre-selected identifier."

Similarly, after researching apples, the user may wish to then research oranges. In such case, the user may "pre-select" the identifier reflecting "oranges" and continue as set forth above, *without* having to "post-select" (i.e. select afterwards) the orange identifier for each orange-related content found during research.

It is noted that IE is simply incapable of such optional, non-limiting example of use, and associated advantages.

Applicant further argues that the Examiner's rejection is still deficient with respect to many additional claims. Just by way of example, the Examiner has not even considered applicant's argument regarding Claim 9. Specifically, the Examiner relies on item 10 from Figure 11 below to make a prior art showing of applicant's claimed "wherein the identifiers include intellectual property identifiers" (see dependent Claim 9).

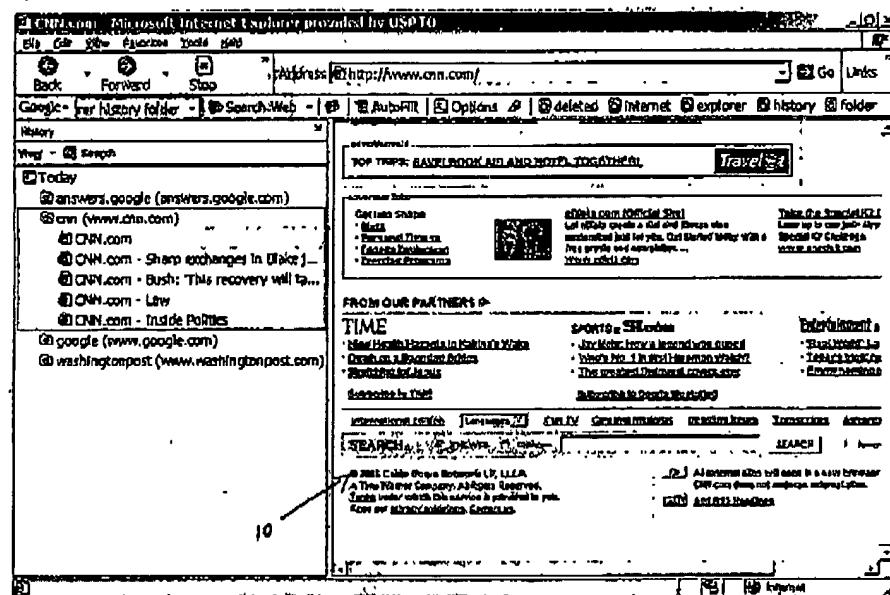


FIG. 11
BEST AVAILABLE COPY

After carefully reviewing such excerpt and the remaining IE reference, however, applicant respectfully disagrees with the Examiner's assertion. IE merely discloses an intellectual property identifier in association with the content browsed during use of the network browser, and not identifiers that include intellectual property identifiers, where the identifiers reside adjacent to the window in which the content is displayed, as claimed.

Again, the anticipation criterion has simply not been met by the current reference, especially in view of the amendments made hereinabove. A notice of allowance or specific prior art showing of each of the foregoing claim elements, in combination with the remaining claimed features, is respectfully requested.

Applicant further argues that the Examiner's rejection is deficient with respect to the recently added claims. Just by way of example, the Examiner has rejected Claims 26-41 under 35 U.S.C. 103(a) as being unpatentable over IE in view of Rivette (USPN 2003/004307). In particular, the Examiner relies on Fig. 22-23B, [0395], [0369], and [0039] from Rivette, in order to meet applicant's claimed "wherein a search is capable of being performed in association with at least one of a plurality of patents using at least one synonym, by:

identifying at least one claim associated with one of the patents,
extracting a plurality of terms from the claim,
identifying at least one synonym associated with at least one of the terms, and
conducting a search utilizing the terms and the at least one synonym" (see Claim 26).

First, it is noted that Fig. 22-23B are completely devoid of any sort of extraction of a plurality of terms from the claim. Further, [0395] makes no mention of the use of a thesaurus specifically with terms extracted from a claim. Finally, there is not even a suggestion of conducting a search based on the foregoing emphasized features.

-18-

It is also noted that the rejection of Claims 27-30 is deficient for similar reasons.

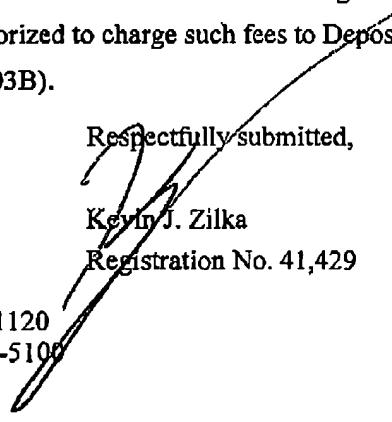
To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991).

Applicants respectfully assert that at least the third element of the *prima facie* case of obviousness has not been met, for the reasons set forth hereinabove. A notice of allowance or specific prior art showing of each of the foregoing claim elements, in combination with the remaining claimed features, is respectfully requested.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 505-5100. For payment of any fees due in connection with the filing of this paper, the Commissioner is authorized to charge such fees to Deposit Account No. 50-1351 (Order No. SVIPGP003B).

Respectfully submitted,


Kevin J. Zilka

Registration No. 41,429

P.O. Box 721120
San Jose, CA 95172-1120
Telephone: (408) 505-5100